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Mailed: 1-3-06
In re application of :
Philippe Renard et al. : DECISION ON
Serial No. 09/977,698 : PETITION
Filed: October 16, 2001 :
For: THIN COMPOSITE LAMINATE AND USE THEREOF IN MAKING SPORTS
ARTICLES, ESPECIALLY BOOTS

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT filed August 23, 2005.

On July 13, 2005, a final office action was mailed to Applicants, rejecting all of the pending claims under 35 USC 112 2nd paragraph as being indefinite. Applicants responded to this office action with an amendment after final which was filed on August 23, 2005. The examiner refused entry of the amendment in an advisory action mailed September 14, 2005. A request for reconsideration was filed on September 16, 2005

On November 1, 2005, the instant petition under 37 CFR 1.181 was timely filed to request the entry of the after final amendment of August 23, 2005.

Petitioner's position is that the amendment after final did not raise any new issues as alleged by the examiner in the advisory action and that the amendment further reduces the issues for appeal.

DECISION

Section 714.13 of the MPEP states in part:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection.

ACTION BY EXAMINER

See also MPEP § 706.07(f).

The refusal to enter the proposed amendment should not be arbitrary. The proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.

In the final rejection mailed July 13, 2005, all of the claims were rejected under 35 USC 112 2nd paragraph as being indefinite. The examiner's position was that the phrases "significantly lower" in claim 73 and "the predetermined magnitude" in claim 74 were both indefinite. The examiner also stated that the claims would be allowable if rewritten to overcome the 35 USC 2nd paragraph rejections.

In the amendment filed on August 23, 2005, Applicants amended the claims to overcome the 35 USC 112, second paragraph rejections. Claim 25, which was indicated as allowable in the final office action was placed into claim 73 in order to make the claim definite. Applicants repeated a limitation already found in claim 74 in order to eliminate the language objected to by the examiner. In the advisory action, the examiner stated that the amendments raised new issues which would require further search and/or consideration. Specifically, the examiner stated that claim 73 was substantially amended and now requires the fibers of the core to be selected from specific material. The examiner further stated that claim 74 requires the composite layers to have specific modulus in longitudinal traction. After applicants filed a request for reconsideration, the examiner prepared another advisory action and stated that the amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

It is clear that the examiner has not properly followed the guidelines set forth in the MPEP above. With respect to the limitations added to claim 73, the examiner is clearly in error when he states, the amendment would require a new search and or consideration. The subject matter of newly amended claim 73 was already determined to be allowable by the examiner in the final office action. It is unclear as to how subject matter already determined to be allowable by the examiner would require further search and/or consideration. As for claim 74, the amendment does not change the scope of the claim in any way. The amendment merely repeats a definition already present in the claim and deletes the language that the examiner found objectionable. Presumably, the examiner had already considered the newly added language to the claim in that it was already present in the claim in an earlier portion of said claim. Once again, it is unclear as to how this could be a new issue in that the scope of the claim was not changed. As to whether the amendments place the application in better form for appeal and/or simplify the issues, it is clear that the amendments place the application in condition for allowance as recommended by the examiner in the final office action thereby simplifying the issues.

As the amendments adopted the examiner's suggestions in the final office action and should have required merely a cursory review by the examiner to recognize that the claims were placed in condition for allowance (as explained in the MPEP above), the amendments clearly should have been entered by the examiner.

Accordingly, the petition for entry of the after final amendment is **GRANTED**. The examiner is directed to enter the amendment after final and take further appropriate action.

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